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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,124	04/08/2004	Shenshen Wu	20002.0331	8652

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,124

Applicant(s)

WU ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 9-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 calls for a trimer of HDMI which is not one the two possible trimers named in claim 1.

Claim 9's language is confusing. The amendment requires the trifunctional component to one of the two named isocyanates. However, the claim's retained language indicates the trifunctionality can be provided by trifunctional amines or trifunctional curing agents. This language is contradictory and/or superfluous.

Claims 1-3,6-8 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Crast '012.

Crast exemplifies (table 2) golf ball coatings utilizing isocyanurate trimers of toluene diisocyanate. Presumably, the reference material would inherently have the same COR vs temp profile as the instant claims because the same materials appear to be used. Note that claim 7 doesn't require the trifunctional curing agent be present because the claim merely further limits what qualifies as triamines in claim 1's trifunctional isocyanate, triamine Markush group.

Claims 6 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kennedy '220.

Kennedy claims (#5) golf ball coatings utilizing trimers of hexamethylene diisocyanate. Presumably, the reference material would inherently have the same COR vs temp profile as the instant claims because the same materials appear to be used.

Claim 6 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu '176.

Wu teaches polyurethane covers for golf balls. The urethane can be based on triisocyanate of HDI (ie isocyanurate trimer of HDI, col 5 line 23). Presumably, the reference material would inherently have the same COR vs temp profile as the instant claims because the same material appears to be used.

Claims 1-13 rejected under 35 U.S.C. 102(a,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu 2003/0096936.

Wu claims golf ball covers of polyurea prepolymer and curing agent (claim 1). The isocyanate used to make the urea can be an isocyanurate of toluene diisocyanate (paragraph 64). Many of the amines are trifunctional (claim 6). The urea prepolymer can be made from propylene oxide based triamines (claim 6). Presumably, the reference material would inherently have the same COR vs temp profile as the instant claims because the same materials appear to be used.

Claims 1-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wu 2002/0173379.

Wu produces urethanes for golf balls (abstract). The urethane can be derived from trimerized isocyanurates such as the isocyanurate of toluene diisocyanate (paragraph 47). Presumably, the reference material would inherently have the same

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COR vs temp profile as the instant claims because the same materials appear to be used.

Claims 1-13 and 28-31 rejected under 35 U.S.C. 102(a,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rajagopalan 2003/0144087.

Rajagopalan claims (#9) a golf ball of a polyurea derived from a polyamine such as propylene oxide based triamine or glycerin based triamine. The isocyanate used can be trimerized isocyanurates such as the isocyanurate of toluene diisocyanate (paragraph 168). Presumably, the reference material would inherently have the same COR vs temp profile as the instant claims because the same materials appear to be used.

Claims 1-8 and 28-31 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6939907. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims golf balls having a cover derived from glycerin based triamine or propylene oxide based triamine. Presumably, the reference material would inherently have the same COR vs temp profile as the instant claims because the same materials appear to be used.

Applicant's arguments filed 3/17/06 have been fully considered but they are not persuasive.

Applicant argues Crast and Kennedy do not suggest the triamines of the claims.

This is not convincing. Claim 1 requires a trifunctional isocyanate OR a trifunctional amine. Triamines are not required. Therefore, references directed to trifunctional isocyanates meet the claims.

Applicant argues Wu '176 does not suggest the trifunctional curing agents of claim 1.

Again, claim 1 does not requires trifunctional curing agents (ie triamines). Trifunctional isocyanates also meet the claim. Wu '176 does recite one of claim 6's trifunctional isocyanates.

Applicant argues Wu '936 does not teach the trifunctional isocyanates or triamines now required.

This is not accurate. Paragraph 64 of the reference does recite isocyanurates of toluene diisocyanate. Claim 6 of the reference does recite some of applicant's preferred triamines. Also note the reference qualifies under 102(a) having been published before applicant's filing date. Common ownership does not remove anticipatory references or references available under 102(a). See MPEP 706.02(1)(3).

The terminal disclaimer removes the previous obviousness double patenting rejections.

Limiting the species of trifunctional isocyanates (by eliminating trimer of HMDI) and limiting species of triamines (by eliminating diethylene triamine) are new issues requiring the added rejections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

David Buttner

5/19/06

A handwritten signature in black ink, appearing to read "David Buttner", written in a cursive style.